

## **REMARKS/ARGUMENTS**

Claims 1-12 are pending in the application. The claims are all rejected under 35 U.S.C. §103 as discussed further below, which rejection is respectfully traversed. Reconsideration of the application is respectfully solicited based on the remarks provided herein.

### **Withdrawal of Prior Claim Rejection**

Applicants note with appreciation the Examiner's withdrawal, at p. 2 of the present Office Action, of the rejection set forth in the previous Office Action dated July 15, 2010, wherein claims 1-12 were rejected under 35 U.S.C. §103 over Schumacher et al. U.S. Patent Publication No. 2003/0104198 taken in combination with Argoitia et al. U.S. Patent Publication No. 2003/0190473.

### **Discussion of New Claim Rejection Under 35 U.S.C. §103**

In the present Office Action, however, the Examiner raises a new ground of rejection under 35 U.S.C. §103 wherein claims 1-12 are rejected as being allegedly unpatentable over Müller-Rees et al. USP 5,851,277 in view of Schmid et al. USP 6,533,857. According to the Action on p. 6, Müller-Rees et al. do not explicitly disclose that the effect pigments have at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment, however this deficiency is allegedly cured by the teachings of Schmid et al. Further according to the Examiner, it would have been *prima facie* obvious for one of ordinary skill at the time of the present invention to combine the respective teachings of Müller-Rees *et al.* and Schmid et al. to devise applicants' claimed UV-protective cosmetic preparation and the method of making the same. This new rejection is respectfully traversed for the reasons which follow.

Before discussing the prior art now cited by the Examiner it is believed that a brief, non-limiting description of what is being claimed by applicants will assist in highlighting for the Examiner the features that distinguish the presently claimed composition and method over the cited combination.

The present application contains two independent claims, i.e., claim 1 directed to a UV-protective cosmetic preparation and claim 8 to a method for the production of such a UV-protective cosmetic preparation. Claim 1 reads as follows:

1. A UV-protective cosmetic preparation for application to skin comprising one or more UV absorbers, characterized in that said cosmetic preparation contains effect pigments, which effect pigments have a laminar structure and at least one protective coating of silicon dioxide, and wherein the effect pigments contain titanium dioxide, said at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment to prevent titanium dioxide induced breakdown of the UV absorbers, wherein said effect pigments align parallel to skin when said preparation is applied to skin, whereby, depending on the angle of incidence of light, the skin would appear to have a different color or a different color shade.

Claim 8, then, recites method as follows:

8. A method for the production of a UV-protective cosmetic preparation for application to skin that includes at least one UV absorber, said method comprising providing in said preparation as a component thereof, at least one effect pigment, wherein the at least one effect pigment has a laminar structure and at least one protective coating of silicon dioxide, wherein the at least one effect pigment contains titanium dioxide, wherein said at least one coating of silicon dioxide isolates the titanium dioxide from its environment to prevent titanium dioxide induced breakdown of the UV absorber, wherein said effect pigments align parallel to skin when said preparation is applied to skin, whereby, depending on the angle of incidence of light, the skin would appear to have a different color or a different color shade.

Turning, then, to a discussion of the prior art references cited in combination to reject applicants' claims, the Müller-Rees patent is directed to a cosmetic preparation comprising pigments. The preparation described in the subject reference may additionally comprise, moreover, interference color pigments or metal luster pigments (see, e.g., claim 8). The reference is completely silent, however, as noted even by the Examiner, with regard to the existence of a protective coating of silicon dioxide on effect pigments containing titanium dioxide. The reference is additionally lacking, moreover, any teaching or disclosure that would lead one having an ordinary level of skill in this art to understand that irradiation of titanium

dioxide-containing effect pigments induces a breakdown of organic substances - such as UV absorbers. As a consequence of the degradation of such UV-absorbers, while individuals applying a respective cosmetic product believe that they are protected against UV radiation, actually they lack protection against such radiation. This lack of protection is attributable to the fact that the UV-absorbers are degraded due to the photocatalytical activity of the titanium dioxide. This, then, leads to an increased risk of skin cancer in those lacking such UV protection.

Turning, next, to the Schmid reference that is combined with Müller-Rees to reject applicants' claims, the reference generally discloses numerous effect pigments which include an outer protective layer. The reference, however, is completely silent with respect to a UV-protective cosmetic preparation comprising, specifically, titanium dioxide-containing effect pigments as well as UV absorbers, and wherein the pigments are coated with silicon dioxide to isolate the titanium dioxide from its environment.

As may be deduced from Schmid at col. 8, lines 59 to 61, the protective layer is applied to enable the use of the pigments in waterborne coatings or in other types of aqueous systems. The reason for the use of a layer ( C ) is to protect a substantially metallic layer ( B ) against corrosion. Thus, the protective layer serves to protect the metallic core of the pigments against the effects due to the environment. This is a subtle yet decisive difference.

Neither Müller-Rees nor Schmid evidence any recognition of the problem that titanium dioxide in effect pigments leads to degradation of organic compounds, and in particular, of UV-absorbers. In view of the fact, therefore, that these documents did not even recognize that there is a serious problem in regard to the health of humans that is attributable to the degradation of such organic compounds, applicants respectfully submit that their combined disclosure does not render obvious the cosmetic preparation and method recited in the pending set of claims. As indicated above, one having an ordinary level of skill in this art would only consider using the pigments disclosed in Schmid if the pigments were to be used in a waterborne coating or in some other aqueous system.

In view of the fact that corrosion of the pigments is not a problem, however, in the cosmetic preparations according to Müller-Rees, one of ordinary skill in the art would not

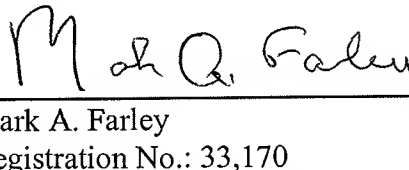
contemplate using the pigments disclosed in Schmid, having a separate expensive layer, as there would be no obvious need for using such a modified pigment.

In sum, therefore, the UV-protective cosmetic preparation recited in pending claim 1, as well as the method of preparing such composition recited in claim 8, involving the use of titanium dioxide-containing effect pigments having a protective silicon dioxide coating isolating the titanium dioxide from its environment, i.e., to protect the UV absorbers, would not be obvious to one having an ordinary level of skill at the time the present preparation and method was developed over the combined disclosure of Müller-Rees and Schmid.

The Examiner is, therefore, respectfully requested to reconsider and withdraw the rejection under §103 of applicants' claims 1-12.

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Respectfully submitted,

A handwritten signature in cursive script, reading "Mark A. Farley", is written over a horizontal line.

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